

PATENT
Docket No. **03-1025**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:) **Mail Stop Appeal Brief - Patents**
Craig L. REDING et al.)
) Group Art Unit: 2617
Application No.: 10/720,825)
) Examiner: H. Phan
Filed: November 24, 2003)
)
For: METHODS AND SYSTEMS FOR)
SINGLE NUMBER TEXT)
MESSAGING)

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

APPEAL BRIEF

This Appeal Brief is submitted in response to the final Office Action, dated August 14, 2007, and in support of the Notice of Appeal, filed November 7, 2007. This Appeal Brief is also being submitted in response to the Notice of Panel Decision from Pre-Appeal Brief Review, dated January 14, 2008. This Appeal Brief is accompanied by a Petition for a Three-Month Extension of Time.

I. **REAL PARTY IN INTEREST**

The real party in interest of the present application, solely for purposes of identifying and

avoiding potential conflicts of interest by board members due to working in matters in which the member may have a financial interest, is Verizon Communications Inc. and its subsidiary companies, which currently include Verizon Business Global, LLC (formerly MCI, LLC) and Cellco Partnership (doing business as Verizon Wireless, and which includes as a minority partner affiliates of Vodafone Group Plc). Verizon Communications Inc. or one of its subsidiary companies is an assignee of record of the present application.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

Appellants are unaware of any related appeals, interferences or judicial proceedings.

III. STATUS OF CLAIMS

Claims 1-7, 9, 10, 12, 13, 16, and 17 are pending in this application.

Claims 1-7, 9, 10, 12, 13, 16, and 17 were rejected in the final Office Action, dated August 14, 2007, and are the subject of the present appeal. These claims are reproduced in the Claim Appendix of this Appeal Brief.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the final Office Action, dated August 14, 2007. Appellants filed a Request for Reconsideration on September 28, 2007. A subsequent Advisory Action, dated October 25, 2007, indicated that the Request for Reconsideration has been considered, but did not place the application in condition for allowance. Appellants also filed a Pre-Appeal Brief Request for Review on November 7, 2007. A subsequent Notice of Panel

Decision from Pre-Appeal Brief Review, dated January 14, 2008, indicated that there is at least one actual issue for appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In the paragraphs that follow, a concise explanation of the independent claims, each dependent claim argued separately, and the claims reciting means-plus-function or step-plus-function language that are involved in this appeal will be provided by referring, in parenthesis, to examples of where support can be found in the specification and drawings.

Claim 1 is directed to a method for providing SMS messages to a receiving party (e.g., 110, Fig. 1) associated with a plurality of devices (e.g., 112, 114, 116, 118, Fig. 1). The method comprises receiving a SMS message for a first device of the plurality of devices (e.g., 710-740, Fig. 7; p. 34, lines 1-6); identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party (e.g., 750, Fig. 7; p. 31, lines 6-14; p. 34, lines 6-8); formatting the SMS message according to characteristics of the preferred device (e.g., p. 31, lines 6-14); and sending the formatted message to the preferred device (e.g., p. 760, Fig. 7; p. 34, lines 8-9).

Claim 4 recites that the sending the formatted message comprises sending the formatted message to an instant messenger client (e.g., p. 33, lines 1-9).

Claim 5 recites that the sending the formatted message comprises sending the formatted message as a voice message to a phone (e.g., p. 33, lines 10-17).

Claim 9 is directed to an apparatus for providing SMS messages to a user associated with a plurality of devices, comprising a database for storing information identifying each device of

the plurality of devices and identifying a first device of the plurality of devices as a preferred device (e.g., 522, Fig. 5; p. 30, lines 14-19); a gateway server for receiving a SMS message identifying a second device of the plurality of devices (e.g., 630, Fig. 6; p. 30, line 20 to p. 31, line 5); a server function for identifying the preferred device instead of the second device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the second device (e.g., 516, Fig. 5; 640, Fig. 6; p. 30, lines 14-19; p. 31, lines 6-14); and a SMS server for sending the SMS message to the preferred device, the SMS server being further configured to format the SMS message in accordance with characteristics of the preferred device before sending the SMS message to the preferred device (e.g., 640, Fig. 6; p. 31, lines 6-14).

Claim 10 recites that the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages (e.g., p. 37, lines 1-3).

Claim 12 is directed to an apparatus for providing SMS messages to a user associated with a plurality of devices, comprising means for storing a specification of a preferred device (e.g., 522, Fig. 5; p. 30, lines 14-19); means for receiving a SMS message identifying one device of the plurality of devices (e.g., 630, Fig. 6; p. 30, line 20 to p. 31, line 5); means for selecting the preferred device instead of the identified one device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the identified one device (e.g., 516, Fig. 5; 640, Fig. 6; p. 30, lines 14-19; p. 31, lines 6-14); and means for sending the SMS message to the preferred device, the means for sending the SMS message comprising means for formatting the SMS message in accordance with characteristics of the preferred device before sending the SMS message to the preferred device (e.g., 640, Fig. 6; p. 31, lines 6-14).

Claim 13 recites that the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages (e.g., 640, Fig. 6; p. 37, lines 1-3).

Claim 16 is directed to a method comprising receiving a SMS message including information identifying a first destination device (e.g., 710-740, Fig. 7; p. 34, lines 1-6); identifying a second destination device instead of the first destination device for receiving the SMS message in response to receiving the SMS message, the second destination device being different than the first destination device (e.g., 750, Fig. 7; p. 31, lines 6-14; p. 34, lines 6-8); formatting the SMS message based on the second destination device (e.g., p. 31, lines 6-14); and sending the formatted SMS message to the second destination device (e.g., p. 760, Fig. 7; p. 34, lines 8-9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over KARVE (U.S. Patent Application Publication No. 2002/0137530) in view of PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906).

B. Claim 3 stands rejected under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of GOPINATH et al. (U.S. Patent Application Publication No. 2004/0002350).

C. Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of DEHLIN (U.S. Patent Application Publication No. 2004/0203942).

D. Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of SABO et al. (U.S. Patent Application Publication No. 2003/0096626).

E. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over KARVE in view of PACKHAM et al., and further in view of FOSTICK et al. (U.S. Patent Application Publication No. 2002/0187794).

VII. ARGUMENTS

A. The rejection of claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530) and PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906) should be reversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (CCPA 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). KSR International Co. v. Teleflex Inc., 550 U.S. ____ (April 30, 2007). The Examiner is also required to explain how and why one having ordinary skill in the art would have been realistically motivated to modify an applied reference and/or combine applied references to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

1. Claims 1, 2, and 6.

Independent claim 1 is directed to a method for providing SMS messages to a receiving party associated with a plurality of devices. The method includes receiving a SMS message for a first device of the plurality of devices; identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party; formatting the SMS message according to characteristics of the preferred device; and sending the formatted message to the preferred device. KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

For example, KARVE and PACKHAM et al. do not disclose or suggest identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party. The Examiner relies on paragraphs 0032-0035 of KARVE for allegedly disclosing "identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party" and relies on paragraphs 0019-0022 of PACKHAM et al. for allegedly disclosing "instead of the first device for receiving the SMS message" (final Office Action, p. 5). Appellants submit that the Examiner's piecemeal examination of the above feature of claim 1 is improper.

Claim 1 does not recite "identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party" and "instead of the first device for receiving the SMS message." In contrast, claim 1 specifically recites "identifying a second device of the plurality of devices as a preferred device

instead of the first device for receiving the SMS message based on information stored by the receiving party." Rather than addressing this specifically-recited feature of claim 1, the Examiner breaks the feature down into illogical parts by pointing to portions of one reference for allegedly disclosing identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party and to unrelated portions of a second reference for allegedly disclosing instead of the first device for receiving the SMS message. Such attempts at reconstructing Appellants' claims are clearly impermissible.

Nevertheless, PACKHAM et al. is directed to a system where forwarding information is stored in a home location register (HLR) so that text messages received by a Short Message Service Gateway Mobile Switching Center (SMS/GMSC) for one device can be forwarded to a second device (see paragraphs 0019-0022). Thus, in PACKHAM et al., the SMS/GMSC performs the forwarding of text messages.

In stark contrast, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). Thus, in KARVE, the cellular telephone performs the forwarding of received SMS messages. Therefore, all SMS messages in KARVE that are for the cellular telephone (which the Examiner specifically indicates corresponds to the first device in claim 1) must be received by the cellular telephone in order for the forwarding to take place.

Accordingly, if, as the Examiner alleges, the system of KARVE were modified to incorporate the teachings of PACKHAM et al., such a combination would result in a system that forwards text messages away from KARVE's cellular telephone before they reach the telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an

SMS message and forwards the SMS message to another number or device) inoperable. In any case, it would not result in the method recited by claim 1.

Appellants further submit that one skilled in the art would not reasonably look to incorporate PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device into the KARVE system since the KARVE system is directed to actions performed by a cellular device (the first device). If one were to incorporate PACKHAM et al.'s HLR and SMS/GMSC into the KARVE system, this combination would obviate the need for the KARVE system since the forwarded destination of the text message is identified prior to reaching the first device (KARVE's cellular device).

With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, p. 6). Appellants respectfully disagree with the Examiner's allegations.

As indicated above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless.

With respect to the above arguments, the Examiner alleges (in part):

The second criteria of a reasonable expectation of success was met since both references are from a similar field of endeavor such particularly as a method for forwarding SMS in the wireless communication system, and the combination of

the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success

(final Office Action, p. 2). Appellants respectfully disagree.

As set forth above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless. That is, incorporating PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device into the KARVE system would result in text messages being routed away from KARVE's cellular telephone (which the Examiner specifically indicates corresponds to the recited first device), which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

The Examiner further alleges:

Karve clearly discloses that Karve's system is the same as Packham's system described as "SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages" (see [0007]). But, Karve does not particularly show instead of the first device for receiving the SMS message, thus there is a need for applying the teaching of Packham that instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]) in order for people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, pp. 3-4; Advisory Action, p. 2). Appellants submit that the Examiner continues to ignore the fact that if PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first

device to a second device were to be incorporated into KARVE's system, the result would be text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

For at least the foregoing reasons, Appellants submit that the rejection of claim 1 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claims 2 and 6 depend from claim 1. Therefore, Appellants respectfully request that the rejection of claims 2 and 6 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. be reversed for at least the reasons given above with respect to claim 1.

2. Claim 9.

Independent claim 9 is directed to an apparatus for providing SMS messages to a user associated with a plurality of devices. The apparatus comprises a database for storing information identifying each device of the plurality of devices and identifying a first device of the plurality of devices as a preferred device; a gateway server for receiving a SMS message identifying a second device of the plurality of devices; a server function for identifying the preferred device instead of the second device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the second device; and a SMS server for sending the SMS message to the preferred device, the SMS server being further configured to format the SMS message in accordance with characteristics of the preferred device before sending the SMS message to the preferred device. KARVE and PACKHAM et al.,

whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

For example, KARVE and PACKHAM et al. do not disclose or suggest a database for storing information identifying each device of the plurality of devices and identifying a first device of the plurality of devices as a preferred device. The Examiner relies on paragraph 0033 of KARVE for allegedly this feature (final Office Action, p. 7). Appellants respectfully disagree with the Examiner's interpretation of KARVE.

At paragraph 0033, KARVE discloses:

However, as will be understood by those of ordinary skill in the art, with the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center, it is possible to send the message once to the SMS center, with the header portion of the message identifying a pointer to a multiple destination address stored in a memory at the SMS center.

This section of KARVE discloses that a user may define forwarding address lists at the SMS center so that KARVE's telephone 10 needs to only send a single message to the SMS center in order to have the message delivered to multiple destination addresses (instead of sending multiple messages to the SMS center – one for each destination address). This section of KARVE does not disclose or suggest a database for storing information identifying each device of the plurality of devices associated with a user and identifying a first device of the plurality of devices associated with the user as a preferred device, as recited in claim 9. KARVE does not disclose or suggest that the forwarding address lists store information identifying each device of a plurality of devices associated with a user and identifying a first device of the plurality of devices associated with the user as a preferred device, as would be required by KARVE based on the Examiner's interpretation of claim 9.

The disclosure of PACKHAM et al. does not remedy the above deficiency in the disclosure of KARVE. Appellants note that PACKHAM et al. discloses a register that is interrogated to provide routing information to a first terminal for a text message and provides routing information to a second terminal (see, for example, paragraph 0015). A register that stores text message forwarding information, as disclosed by PACKHAM et al., is not equivalent to a database for storing information identifying each device of the plurality of devices associated with a user and identifying a first device of the plurality of devices associated with the user as a preferred device, as recited in claim 9.

KARVE and PACKHAM et al. do not further disclose or suggest a server function for identifying the preferred device instead of the second device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the second device, as also recited in claim 9. The Examiner relies on paragraph 0033 of KARVE for allegedly disclosing "a server function for identifying the preferred device in response to receiving the SMS message, the preferred device being different than the second device" and relies on Fig. 1 and paragraphs 0019-0022 of PACKHAM et al. for allegedly disclosing "instead of the second device for receiving the SMS message" (final Office Action, p. 7). Appellants submit that the Examiner's piecemeal examination of the above feature of claim 9 is improper.

Claim 9 does not recite "a server function for identifying the preferred device in response to receiving the SMS message, the preferred device being different than the second device" and "instead of the second device for receiving the SMS message." In contrast, claim 9 specifically recites "a server function for identifying the preferred device instead of the second device for receiving the SMS message in response to receiving the SMS message, the preferred device

being different than the second device." Rather than addressing this specifically-recited feature of claim 9, the Examiner breaks the feature down into illogical parts by pointing to a portion of one reference for allegedly disclosing a server function for identifying the preferred device in response to receiving the SMS message, the preferred device being different than the second device and to unrelated portions of a second reference for allegedly disclosing instead of the second device for receiving the SMS message. Such attempts at reconstructing Appellants' claims are clearly impermissible.

Nevertheless, PACKHAM et al. is directed to a system where forwarding information is stored in a home location register (HLR) so that text messages received by a Short Message Service Gateway Mobile Switching Center (SMS/GMSC) for one device can be forwarded to another device (see Fig. 1 and paragraphs 0019-0022). Thus, in PACKHAM et al., the SMS/GMSC performs the forwarding of text messages.

In stark contrast, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number, device, or group of devices (see, for example, Abstract and paragraph 0033). Thus, in KARVE, the cellular telephone performs the forwarding of received SMS messages. Therefore, all SMS messages in KARVE that are for the cellular telephone (which corresponds to the second device in claim 9) must be received by the cellular telephone in order for the forwarding to take place.

Accordingly, if, as the Examiner alleges, the system of KARVE were modified to incorporate the teachings of PACKHAM et al., such a combination would result in a system that forwards text messages away from KARVE's cellular telephone before they reach the telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an

SMS message and forwards the SMS message to another number, device, or group of devices)

inoperable. In any case, it would not result in the apparatus recited by claim 9.

Appellants further submit that one skilled in the art would not reasonably look to incorporate PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device into the KARVE system since the KARVE system is directed to actions performed by a cellular device (the one device for which the text message is intended). If one were to incorporate PACKHAM et al.'s HLR and SMS/GMSC into the KARVE system, this combination would obviate the need for the KARVE system since the forwarded destination of the text message is identified prior to reaching the one device (KARVE's cellular device).

With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, p. 8). Appellants respectfully disagree with the Examiner's allegations.

As indicated above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless.

Appellants submit that one skilled in the art at the time of Appellants' invention would not have been motivated to incorporate PACKHAM et al.'s alleged disclosure of instead of the second device for receiving the SMS into the KARVE system, absent impermissible hindsight.

With respect to similar arguments presented with respect to claim 1, the Examiner alleges
(in part):

The second criteria of a reasonable expectation of success was met since both references are from a similar field of endeavor such particularly as a method for forwarding SMS in the wireless communication system, and the combination of the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success

(final Office Action, p. 2). Appellants respectfully disagree.

As set forth above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless. That is, incorporating PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device into the KARVE system would result in text messages being routed away from KARVE's cellular telephone (which the Examiner specifically indicates corresponds to the recited second device), which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

The Examiner further alleges:

Karve clearly discloses that Karve's system is the same as Packham's system described as "SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages" (see [0007]). But, Karve does not particularly show instead of the first device for receiving the SMS message, thus there is a need for applying the teaching of Packham that instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]) in order for

people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, pp. 3-4; Advisory Action, p. 2). Appellants submit that the Examiner continues to ignore the fact that if PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for a first device to a second device were to be incorporated into KARVE's system, the result would be text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

For at least the foregoing reasons, Appellants submit that the rejection of claim 9 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

3. Claim 10.

Claim 10 depends from claim 9. Therefore, this claim is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 9. Moreover, this claim is patentable over KARVE and PACKHAM et al. for reasons of its own.

Claim 10 recites that the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages. The Examiner relies on paragraphs 0007 and 0028-0029 of KARVE for allegedly disclosing this feature (final Office Action, p. 8). Appellants respectfully disagree with the Examiner's interpretation of KARVE.

At paragraph 0007, KARVE discloses:

SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages.

This section of KARVE discloses that SMS messages are sent from a sender to a recipient via an SMS Center. This section of KARVE in no way discloses or suggests an SMS server that is configured to store messages to a database when the preferred device is not available to receive messages, as recited in claim 10. One skilled in the art at the time of Appellants' invention would not reasonably construe KARVE's disclosure of at least one message center to handle and manage short messages as equivalent to or as including an SMS server that is configured to store messages to a database when the preferred device is not available to receive messages, as recited in claim 10.

At paragraphs 0028-0029, KARVE discloses:

The telephone 10 is capable of receiving a SMS short message, also known as a Protocol Data Unit (PDU). A short message includes two parts, header information and short message text, which is also referred to as the user data. The header parameters include the address of the SMS Center to which the short message is to be sent, a Destination Address field denoting the final recipient of the short message, and the Originating Address, which is the address of the sender of the short message. The short message is sent from a mobile telephone or other device to an SMS Center. The SMS center looks at the header information, adds some additional header information, and then tries to send the user data to the recipient or destination address. The format of short messages, sending and receiving of short messages, and the operations of SMS centers are well known to those of skill in the art.

Referring now to FIG. 3, the telephone 10 includes program code for forwarding a received short message from the telephone 10 to another device or telephone. FIG. 3 is a flow diagram of a sequence of steps of such a call forwarding feature in accordance with the present invention.

This section of KARVE discloses that an SMS center looks at header information of a received

short message, adds some additional header information, and then tries to send the user data to the recipient or destination address. This section of KARVE in no way discloses or suggests an SMS server that is configured to store messages to a database when the preferred device is not available to receive messages, as recited in claim 10. This section of KARVE does not even mention what happens if KARVE's cellular telephone 10 is not available to receive messages.

Moreover, it appears that the Examiner is now contending that KARVE's cellular telephone 10 corresponds to the recited preferred device. The Examiner's apparent interpretation of the term "preferred device" is in stark contrast to the Examiner's interpretation of this same term in claim 9 (where the Examiner specifically indicated that KARVE's cellular telephone 10 corresponds to the recited second device – see p. 7 of the final Office Action), from which claim 10 depends. Clearly, such attempts at interpreting claim terms are impermissible.

The disclosure of PACKHAM et al. does not remedy the above deficiencies in the disclosure of KARVE.

For at least the foregoing reasons, Appellants submit that the rejection of claim 10 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

4. Claim 12.

Independent claim 12 is directed to an apparatus for providing SMS messages to a user associated with a plurality of devices. The apparatus comprises means for storing a specification of a preferred device; means for receiving a SMS message identifying one device of the plurality of devices; means for selecting the preferred device instead of the identified one device for receiving the SMS message in response to receiving the SMS message, the preferred device

being different than the identified one device; and means for sending the SMS message to the preferred device, the means for sending the SMS message comprising means for formatting the SMS message in accordance with characteristics of the preferred device before sending the SMS message to the preferred device. KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

For example, KARVE and PACKHAM et al. do not disclose or suggest means for selecting the preferred device instead of the identified one device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the identified one device. The Examiner relies on paragraphs 0027-0035 of KARVE for allegedly disclosing "means for selecting the preferred device in response to receiving the SMS message, the preferred device being different than the identified one device" and relies on Fig. 1 and paragraphs 0019-0022 of PACKHAM et al. for allegedly disclosing "instead of the identified one device for receiving the SMS message" (final Office Action, p. 9). Appellants submit that the Examiner's piecemeal examination of the above feature of claim 12 is improper.

Claim 12 does not recite "means for selecting the preferred device in response to receiving the SMS message, the preferred device being different than the identified one device" and "instead of the identified one device for receiving the SMS message." In contrast, claim 12 specifically recites "means for selecting the preferred device instead of the identified one device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the identified one device." Rather than addressing this specifically-recited feature of claim 12, the Examiner breaks the feature down into illogical parts by pointing to a portion of one reference for allegedly disclosing means for selecting the preferred device in

response to receiving the SMS message, the preferred device being different than the identified one device and to unrelated portions of a second reference for allegedly disclosing instead of the identified one device for receiving the SMS message. Such attempts at reconstructing Appellants' claims are clearly impermissible.

Nevertheless, PACKHAM et al. is directed to a system where forwarding information is stored in a home location register (HLR) so that text messages received by a Short Message Service Gateway Mobile Switching Center (SMS/GMSC) for one device can be forwarded to another device (see Fig. 1 and paragraphs 0019-0022). Thus, in PACKHAM et al., the SMS/GMSC performs the forwarding of text messages.

In stark contrast, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number, device, or group of devices (see, for example, Abstract and paragraphs 0027-0035). Thus, in KARVE, the cellular telephone performs the forwarding of received SMS messages. Therefore, all SMS messages in KARVE that are for the cellular telephone (which corresponds to the identified one device in claim 12) must be received by the cellular telephone in order for the forwarding to take place.

Accordingly, if, as the Examiner alleges, the system of KARVE were modified to incorporate the teachings of PACKHAM et al., such a combination would result in a system that forwards text messages away from KARVE's cellular telephone before they reach the telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number, device, or group of devices) inoperable. In any case, it would not result in the apparatus recited by claim 12.

Appellants further submit that one skilled in the art would not reasonably look to

incorporate PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device into the KARVE system since the KARVE system is directed to actions performed by a cellular device (the one device for which the text message is intended). If one were to incorporate PACKHAM et al.'s HLR and SMS/GMSC into the KARVE system, this combination would obviate the need for the KARVE system since the forwarded destination of the text message is identified prior to reaching the one device (KARVE's cellular device).

With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, p. 9). Appellants respectfully disagree with the Examiner's allegations.

As indicated above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless.

Appellants submit that one skilled in the art at the time of Appellants' invention would not have been motivated to incorporate PACKHAM et al.'s alleged disclosure of instead of the second device for receiving the SMS into the KARVE system, absent impermissible hindsight.

With respect to similar arguments presented with respect to claim 1, the Examiner alleges (in part):

The second criteria of a reasonable expectation of success was met since both

references are from a similar field of endeavor such particularly as a method for forwarding SMS in the wireless communication system, and the combination of the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success

(final Office Action, p. 2). Appellants respectfully disagree.

As set forth above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless. That is, incorporating PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device into KARVE's system would result in text messages being routed away from KARVE's cellular telephone (which the Examiner specifically indicates corresponds to the recited identified one device), which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

The Examiner further alleges:

Karve clearly discloses that Karve's system is the same as Packham's system described as "SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages" (see [0007]). But, Karve does not particularly show instead of the first device for receiving the SMS message, thus there is a need for applying the teaching of Packham that instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]) in order for people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, pp. 3-4; Advisory Action, p. 2). Appellants submit that the Examiner continues to ignore the fact that if PACKHAM et al.'s alleged disclosure of an HLR that stores

forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device were to be incorporated into KARVE's system, the result would be text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

For at least the foregoing reasons, Appellants submit that the rejection of claim 12 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

5. Claim 13.

Claim 13 depends from claim 12. Therefore, this claim is patentable over KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 12. Moreover, this claim is patentable over KARVE and PACKHAM et al. for reasons of its own.

Claim 13 recites that the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages. The Examiner relies on paragraphs 0007 and 0028-0029 of KARVE for allegedly disclosing this feature (final Office Action, pp. 9-10). Appellants respectfully disagree with the Examiner's interpretation of KARVE.

Paragraph 0007 of KARVE is reproduced above. This section of KARVE discloses that SMS messages are sent from a sender to a recipient via an SMS Center. This section of KARVE in no way discloses or suggests that the means for sending the SMS message comprises means

for storing messages to a database when the preferred device is not available to receive messages, as recited in claim 13. One skilled in the art at the time of Appellants' invention would not reasonably construe KARVE's disclosure of at least one message center to handle and manage short messages as equivalent to or as including that the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages, as recited in claim 13.

Paragraphs 0028-0029 of KARVE are reproduced above. This section of KARVE discloses that an SMS center looks at header information of a received short message, adds some additional header information, and then tries to send the user data to the recipient or destination address. This section of KARVE in no way discloses or suggests that the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages, as recited in claim 13. This section of KARVE does not even mention what happens if KARVE's cellular telephone 10 is not available to receive messages.

Moreover, it appears that the Examiner is now contending that KARVE's cellular telephone 10 corresponds to the recited preferred device. The Examiner's apparent interpretation of the term "preferred device" is in stark contrast to the Examiner's interpretation of this same term in claim 12 (where the Examiner specifically indicated that KARVE's cellular telephone 10 corresponds to the recited identified one device – see p. 8 of the final Office Action), from which claim 13 depends. Clearly, such attempts at interpreting claim terms are impermissible.

The disclosure of PACKHAM et al. does not remedy the above deficiencies in the disclosure of KARVE.

For at least the foregoing reasons, Appellants submit that the rejection of claim 13 under

35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. is improper. Accordingly,

Appellants request that the rejection be reversed.

6. Claims 16 and 17.

Independent claim 16 is directed to a method that comprises receiving a SMS message including information identifying a first destination device; identifying a second destination device instead of the first destination device for receiving the SMS message in response to receiving the SMS message, the second destination device being different than the first destination device; formatting the SMS message based on the second destination device; and sending the formatted SMS message to the second destination device. KARVE and PACKHAM et al., whether taken alone or in any reasonable combination, do not disclose or suggest this combination of features.

The Examiner relies on paragraphs 0032-0035 of KARVE for allegedly disclosing "identifying a second destination device in response to receiving the SMS message, the second destination device being different than the first destination device" and relies on Fig. 1 and paragraphs 0019-0022 of PACKHAM et al. for allegedly disclosing "instead of the first destination device for receiving the SMS message" (final Office Action, p. 10). Appellants submit that the Examiner's piecemeal examination of the above feature of claim 16 is improper.

Claim 16 does not recite "instead of the identified one device for receiving the SMS message" and "instead of the first destination device for receiving the SMS message." In contrast, claim 16 specifically recites "identifying a second destination device instead of the first destination device for receiving the SMS message in response to receiving the SMS message, the second destination device being different than the first destination device." Rather than

addressing this specifically-recited feature of claim 16, the Examiner breaks the feature down into illogical parts by pointing to a portion of one reference for allegedly disclosing identifying a second destination device in response to receiving the SMS message, the second destination device being different than the first destination device and to unrelated portions of a second reference for allegedly disclosing instead of the first destination device for receiving the SMS message. Such attempts at reconstructing Appellants' claims are clearly impermissible.

With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, pp. 10-11). Appellants respectfully disagree with the Examiner's allegations.

As indicated above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless.

Appellants submit that one skilled in the art at the time of Appellants' invention would not have been motivated to incorporate PACKHAM et al.'s alleged disclosure of instead of the first destination device for receiving the SMS message into the KARVE system, absent impermissible hindsight.

With respect to similar arguments presented with respect to claim 1, the Examiner alleges (in part):

The second criteria of a reasonable expectation of success was met since both references are from a similar field of endeavor such particularly as a method for forwarding SMS in the wireless communication system, and the combination of the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success

(final Office Action, p. 2). Appellants respectfully disagree.

As set forth above, KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless. That is, PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device would result in text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

Moreover, the Examiner's allegation (i.e., that because KARVE and PACKHAM et al. are in the same field of endeavor, the combination of these two documents cannot be "in opposition to either references' functions and operations") lacks merit. As indicated above, incorporating PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device into the KARVE system would result in text messages being routed away from KARVE's cellular telephone (which the Examiner specifically indicates corresponds to the recited first device), which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device)

meaningless.

The Examiner further alleges:

Karve clearly discloses that Karve's system is the same as Packham's system described as "SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages" (see [0007]). But, Karve does not particularly show instead of the first device for receiving the SMS message, thus there is a need for applying the teaching of Packham that instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]) in order for people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022])

(final Office Action, pp. 3-4; Advisory Action, p. 2). Appellants submit that the Examiner continues to ignore the fact that if PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and an SMS/GMSC that forwards text messages intended for one device to another device were to be incorporated into KARVE's system, the result would be text messages being routed away from KARVE's cellular telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) meaningless. The Examiner's allegations to the contrary lack merit.

For at least the foregoing reasons, Appellants submit that the rejection of claim 16 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 17 depends from claim 16. Therefore, Appellants respectfully request that the rejection of claim 17 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM et al. be reversed for at least the reasons given above with respect to claim 16.

B. The rejection of claim 3 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and GOPINATH et al. (U.S. Patent Application Publication No. 2004/0002350) should be reversed.

1. Claim 3.

Claim 3 depends from claim 1. The disclosure of GOPINATH et al. does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Appellants submit that claim 3 is patentable over KARVE, PACKHAM et al., and GOPINATH et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Accordingly, Appellants request that the rejection be reversed.

C. The rejection of claim 4 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and DEHLIN (U.S. Patent Application Publication No. 2004/0203942) should be reversed.

1. Claim 4.

Claim 4 depends from claim 1. The disclosure of DEHLIN does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to

claim 1. Therefore, Appellants submit that claim 4 is patentable over KARVE, PACKHAM et al., and DEHLIN, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Accordingly, Appellants request that the rejection be reversed. Moreover, this claim is patentable over KARVE, PACKHAM et al., and DEHLIN for reasons of its own.

Claim 4 recites that sending the formatted message comprises sending the formatted message to an instant messenger client. The Examiner admits that KARVE and PACKHAM et al. do not disclose this feature and relies on the Abstract and paragraph 0031 of DEHLIN for allegedly disclosing this feature (final Office Action, p. 12). Appellants respectfully disagree with the Examiner's interpretation of DEHLIN.

In the Abstract, DEHLIN discloses:

A method and system for enabling instant messaging on mobile devices is provided. A customized SMS message is created that awakens the mobile device so that instant messaging may be initiated. Once the mobile device is awakened by the customized SMS message, the mobile device responds to the customized SMS message and initiates processing. Based on information obtained, the mobile device creates a reply customized SMS message. The reply customized SMS message is translated into a reply instant message, which is transmitted over a persistent Internet connection to the sender responsible for awakening the mobile device. Alternatively, the mobile device may respond by creating an Internet connection and establishing a chat session over the Internet connection. The chat session allows the exchange of instant messages between the mobile device and the sender responsible for awakening the mobile device.

This section of DEHLIN discloses the use of a customized SMS message to wake up a mobile device so that instant messaging may be initiated and that, in response to the customized SMS message, the mobile device creates a reply customized SMS message, which is translated into a reply instant message and transmitted over a persistent Internet connection to the sender. This section of DEHLIN does not disclose or suggest that sending the formatted message to a

preferred device (which is identified, instead of a first device, for receiving the SMS message) comprises sending the formatted message to an instant messenger client, as recited in claim 4. In fact, this section of DEHLIN does not relate to sending messages to a preferred device.

At paragraph 0031, DEHLIN discloses:

FIG. 4 is a graphical representation generally illustrating the salient portions of a sample customized SMS message 400 suitable for use in the present invention. As an overview, Short Messaging Service (SMS) is a service that allows short text/data messages to be sent and received on Global System for Mobile Communications (GSM) cellular networks. Generally, there are three types of SMS messages: GSM character set-encoded messages (effectively 7-bit encoded text), UCS2-encoded messages (Unicode encoded 16-bit text), and 8-bit binary-encoded messages. Typically, GSM-encoded messages and UCS2-encoded messages are textual and are displayed to the user by a messaging application as soon as they are received, whereas 8-bit binary-encoded messages are generally directed at providing device-specific information, such as device configuration messages.

This section of DEHLIN discloses three different types of SMS messages. This section of DEHLIN does not mention instant messages. Thus, this section of DEHLIN cannot disclose or suggest that sending the formatted message to a preferred device (which is identified, instead of a first device, for receiving the SMS message) comprises sending the formatted message to an instant messenger client, as recited in claim 4.

With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the system of Karve and Packham as taught by Dehlin for purpose of "enabling instant messaging on a mobile device" (see Dehlin's title and specification)

(final Office Action, p. 12). Appellants respectfully disagree.

Appellants submit that the KARVE and PACKHAM et al. systems are not concerned with enabling a mobile device to perform instant messaging, as taught by DEHLIN. Instead, KARVE and PACKHAM et al. are directed to two totally different and non-analogous

techniques for forwarding SMS messages. There would be no need or desire by one skilled in the art to incorporate DEHLIN's method for enabling a mobile device to perform instant messaging.

Appellants submit that the Examiner's allegation is merely a conclusory statement regarding what the Examiner believes to be an alleged benefit of the combination. Such motivation statements have consistently been found to be insufficient for establishing a *prima facie* case of obviousness. In this respect, Appellants rely upon KSR International Co. v. Teleflex Inc., 550 U.S. ____ (April 30, 2007) (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)), where it was held that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. The Examiner does not provide the articulated reasoning required by KSR International Co. Appellants submit that the Examiner's purported motivation to combine the cited references is merely conclusory and based on impermissible hindsight. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 4.

For at least the foregoing reasons, Appellants submit that the rejection of claim 4 under 35 U.S.C. § 103(a) based on KARVE, PACKHAM et al., and DEHLIN is improper. Accordingly, Appellants request that the rejection be reversed.

- D. The rejection of claim 5 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and SABO et al. (U.S. Patent Application Publication No. 2003/0096626) should be reversed.

1. Claim 5.

Claim 5 depends from claim 1. The disclosure of SABO et al. does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Appellants submit that claim 5 is patentable over KARVE, PACKHAM et al., and SABO et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Accordingly, Appellants request that the rejection be reversed. Moreover, this claim patentable over KARVE, PACKHAM et al., and SABO et al. for reasons of its own.

Claim 5 recites that sending the formatted message comprises sending the formatted message as a voice message to a phone. The Examiner admits that KARVE and PACKHAM et al. do not disclose this feature and relies on the paragraph 0031 of SABO et al. for allegedly disclosing this feature (final Office Action, pp. 12-13). With respect to motivation, the Examiner alleges:

it would have been obvious ... to modify the system of Karve and Packham as taught by Sabo for purpose of "in the case of the landline telephone, the translation is preferably to speech in a text-to-speech converter associated with the SMSC" (see Sabo's specification, para. [0013])

(final Office Action, p. 13). Appellants submit that the Examiner's allegation is merely a conclusory statement regarding what the Examiner believes to be an alleged benefit of the combination. Such motivation statements have consistently been found to be insufficient for establishing a *prima facie* case of obviousness. In this respect, Appellants rely upon KSR International Co. v. Teleflex Inc., 550 U.S. ____ (April 30, 2007) (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)), where it was held that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness. The Examiner does not provide the articulated reasoning required by KSR International Co. Appellants submit that the Examiner's purported motivation to combine the cited references is merely conclusory and based on impermissible hindsight. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 5.

For at least the foregoing reasons, Appellants submit that the rejection of claim 5 under 35 U.S.C. § 103(a) based on KARVE, PACKHAM et al., and SABO et al. is improper. Accordingly, Appellants request that the rejection be reversed.

E. The rejection of claim 7 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and FOSTICK et al. (U.S. Patent Application Publication No. 2002/0187794) should be reversed.

1. Claim 7.

Claim 7 depends from claim 1. The disclosure of FOSTICK et al. does not remedy the deficiencies in the disclosures of KARVE and PACKHAM et al. set forth above with respect to claim 1. Therefore, Appellants submit that claim 7 is patentable over KARVE, PACKHAM et al., and FOSTICK et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Accordingly, Appellants request that the rejection be reversed.

VIII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections of claims 1-7, 9, 10, 12, 13, 16, and 17 under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY SNYDER, L.L.P.

By: John E. Harrity, Reg. No. 43367/
John E. Harrity
Registration No. 43,367

Date: May 12, 2008

11350 Random Hills Road
Suite 600

Fairfax, Virginia 22030
(571) 432-0800

CUSTOMER NUMBER: 25537

IX. CLAIM APPENDIX

1. A method for providing SMS messages to a receiving party associated with a plurality of devices, the method comprising:

receiving a SMS message for a first device of the plurality of devices;

identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party;

formatting the SMS message according to characteristics of the preferred device;

and

sending the formatted message to the preferred device.

2. The method of claim 1, wherein sending the formatted message comprises sending the formatted message to a SMS-capable device.

3. The method of claim 1, wherein sending the formatted message comprises sending the formatted message to an e-mail address.

4. The method of claim 1, wherein sending the formatted message comprises sending the formatted message to an instant messenger client.

5. The method of claim 1, wherein sending the formatted message comprises sending the formatted message as a voice message to a phone.

6. The method of claim 1, wherein sending the formatted message comprises sending the formatted message to digital companion client software.

7. The method of claim 1, comprising:
storing messages in a database when the preferred device is not available to receive messages.

8. (Canceled)

9. An apparatus for providing SMS messages to a user associated with a plurality of devices, comprising:
a database for storing information identifying each device of the plurality of devices and identifying a first device of the plurality of devices as a preferred device;
a gateway server for receiving a SMS message identifying a second device of the plurality of devices;
a server function for identifying the preferred device instead of the second device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the second device; and
a SMS server for sending the SMS message to the preferred device, the SMS server being further configured to format the SMS message in accordance with characteristics of the preferred device before sending the SMS message to the preferred device.

10. The apparatus of claim 9, wherein the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages.

11. (Canceled)

12. An apparatus for providing SMS messages to a user associated with a plurality of devices, comprising:

means for storing a specification of a preferred device;

means for receiving a SMS message identifying one device of the plurality of devices;

means for selecting the preferred device instead of the identified one device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the identified one device; and

means for sending the SMS message to the preferred device, the means for sending the SMS message comprising means for formatting the SMS message in accordance with characteristics of the preferred device before sending the SMS message to the preferred device.

13. The apparatus of claim 12, wherein the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages.

14. (Canceled)

15. (Canceled)

16. A method comprising:

receiving a SMS message including information identifying a first destination device;

identifying a second destination device instead of the first destination device for receiving the SMS message in response to receiving the SMS message, the second destination device being different than the first destination device;

formatting the SMS message based on the second destination device; and sending the formatted SMS message to the second destination device.

17. The method of claim 16 wherein the first destination device and the second destination device are associated with a receiving party, and

wherein the identifying includes:

identifying the second destination device based on a profile associated with receiving party.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.